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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,460	06/21/2001	Takenori Kohda	JP920000074US1	6937
30355	7590	10/17/2005		
DANIEL E. JOHNSON IBM CORPORATION, ALMADEN RESEARCH CENTER INTELLECTUAL PROPERTY LAW DEPT. C4TA/J2B 650 HARRY ROAD SAN JOSE, CA 95120-6099			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/887,460

Applicant(s)

KOHDA ET AL.

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/17/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-32 are presented for examination.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-23, are rejected under 102(e) as being anticipated by Sitnik (Patent Number 6,160,570 hereinafter Sitnik).

In reference to claims 1 and 11, Sitnik discloses a method and system for advertising using a computer system or network that provides a contents database for recording image contents and an advertising database for recording advertising data, comprising: generating image contents including advertising frame information (size and location) and recording the contents to a contents database (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 5 lines 57 to col. 6 lines 3); generating advertising data corresponding to the advertising frame information and recording the data to an advertising database (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67); synthesizing and displaying the synthesized contents to a terminal of a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

3. In reference to claims 2 and 12, Sitnik teaches the method and system wherein the generated contents are managed on an object basis (where object basis is interpreted to mean that each image on the television screen for example is an object such as a cereal box on a shelf, a soda can, or a football), and the advertising frame information is associated with a descriptor of each object (col. 4 lines 13-34 and col. 9 lines 48-56).

4. In reference to claims 3 and 13, Sitnik teaches the method and system further comprising: extracting an object from the generated contents, wherein the generated contents are not managed on an object basis (each scene in a program sequence is treated as a whole instead of each image in the scene being treated as an object); and associating the extracted object with corresponding advertising frame information (col. 4 lines 8-13 and col. 9 lines 44-48).

5. In reference to claims 4, 5, and 14, Sitnik teaches the method and system wherein the object is an image object of a static image (i.e. a logo) (col. 4 lines 23-27 and col. 9 lines 48-53), a moving image, or an acoustic object (audio data) (col. 4 lines 2-7).

6. In reference to claims 6 and 15, Sitnik teaches the method and system said synthesizing comprising storing advertising data as contents data of an object associated with the advertising frame information (col. 2 lines 44-55 and col. 5 lines 12-23).

7. In reference to claims 7 and 16, Sitnik teaches the method and system said synthesizing comprising replacing contents data of an object with advertising data

(show an advertisement in the middle of a television program at a certain time for example) (col. 5 lines 56 to col. 6 lines 3, col. 4 lines 8-13, and col. 9 lines 44-48).

8. In reference to claims 8 and 17, Sitnik teaches the method and system said synthesizing comprising superimposing advertising data onto contents data of an object (product placement in a video segment) (col. 2 lines 44-65, col. 4 lines 13-34, col. 5 lines 46-50, and col. 9 lines 21-24, and 48-56).

9. In reference to claims 9 and 19, Sitnik teaches the method said synthesizing comprising: delivering pre-synthesized contents data and the advertising data to a contents user separately; and synthesizing the pre-synthesized data and the advertising data at a terminal system of the contents user (locally) (col. 2 lines 44-55, col. 4 lines 31 to col. 7 lines 40, and Figure 2).

10. In reference to claim 10 and 18, Sitnik teaches the method said synthesizing comprising synthesizing the generated contents before the generated contents are delivered to a contents user and in a delivery source (transmitter for example) (col. 2 lines 5-17 and lines 56-65, col. 3 lines 35 to col. 4 lines 7, and Figure 1).

11. In reference to claims 20 and 21, Sitnik teaches a computer-readable recording media embodying a program executable by a computer, the program comprising (software modules) (col. 6 lines 22 to col. 7 lines 40): means for delivering and reading image contents that include an advertising frame (size and location) information to a contents user (col. 5 lines 57 to col. 6 lines 3 and col. 7 lines 29-40); means for delivering and reading advertising data corresponding to the advertising frame information to the contents user (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67,

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and col. 7 lines 29-40); means for synthesizing and presenting the contents and the advertising data to the contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and 44-56, and col. 7 lines 29-40).

12. In reference to claims 22, Sitnik teaches the computer-readable recording media wherein the program further comprises means for extracting an object from the contents, the contents not being managed on an object basis, and associating the extracted object with the advertising frame information (col. 4 lines 8-13, col. 7 lines 29-40, and col. 9 lines 44-48).

13. In reference to claims 23, Sitnik teaches the computer-readable recording media wherein the program further comprises means for associating a descriptor of an object the contents with the advertising frame information, in which the contents are managed on an object basis (col. 4 lines 13-34, col. 7 lines 29-40, and col. 9 lines 48-56).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 24-32 are rejected under U.S.C. 103(a) as being unpatentable over Sitnik in view of Brown (Patent Number 6,023,686 hereinafter Brown).

In reference to claims 24, 29, and 31, Sitnik teaches an advertising frame

associated with an object constituting image contents (col. 3 lines 60 to col. 4 lines 34, col. 5 lines 51-53, and col. 9 lines 44-56). Sitnik is silent about a transaction method, system, and a computer-readable recording media comprising: presenting sales information of the advertising frame using a computer or computer system; an applicant, who has been looking for an advertisement referring to the sales information, offering to purchase the advertising frame; and when an agreement regarding the advertising frame is transacted, communicating information related to the advertising frame to the applicant who has purchased the advertising frame.

Brown teaches a transaction method, system, and a computer-readable recording media comprising: presenting sales information of the advertising frame (anything that the user wants to purchase i.e. a property for example) using a computer or computer system (col. 3 lines 29-38, col. 6 lines 6-11; lines 60-col. 7 line 1, col. 8 lines 35-41, and Figures 1, 6, and 7); an applicant, who has been looking for an advertisement referring to the sales information, offering to purchase the advertising frame (col. 7 lines 46 to col. 8 lines 13, and Figures 6 and 9); and when an agreement regarding the advertising frame is transacted, communicating information related to the advertising frame to the applicant who has purchased the advertising frame (col. 8 lines 42-61 and Figure 10).

It would have been obvious to modify Sitnik to include a transaction method, system, and computer-readable recording media to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames

online would enable customers to conduct transactions on a global basis.

15. In reference to claim 25, Sitnik teaches producing advertising data corresponding to the advertising frame information (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67); synthesizing and presenting the contents and the advertising data to a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

16. In reference to claim 26, Sitnik does not teach the transaction method wherein said presenting sales information is performed by a system provider upon request of an owner of the contents or an owner of the advertising frame, and the delivery of the contents and the advertising data is performed by the system provider. Brown teaches the transaction method wherein said presenting sales information is performed by a system provider (using the central computer system) upon request of an owner of the contents or an owner of the advertising frame, and the delivery of the contents and the



advertising data is performed by the system provider (col. 3 lines 29-38, col. 6 lines 6-11, lines 60-col. 7 line 1, col. 8 lines 35-61, and Figures 1, 6, 7, and 10). It would have been obvious to modify Sitnik to include a transaction method in which a system provider presents sales information in order to enable the advertisement frame purchaser to view to the transaction cost online before making a purchase.

Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

17. In reference to claim 27, Sitnik teaches the method wherein the system provider acquires the contents from an owner of the contents or an owner of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 5 lines 57 to col. 6 lines 3), and acquires the advertising data from a purchaser of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67), the method further comprising: synthesizing the contents and the advertising data and then delivering the synthesized contents to the contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a

computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

18. In reference to claim 28, Sitnik teaches the transaction method wherein the system provider acquires the contents from an owner of the contents or an owner of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61, col. 3 lines 60-67, and col. 5 lines 57 to col. 6 lines 3), and acquires the advertising data from a purchaser of the advertising frame (col. 2 lines 8-12, 47-52, and 56-61 and col. 3 lines 60-67), the method further comprising delivering contents data associated with the advertising frame information and the advertising data separately (not pre-superimposed) to the contents user (col. 44-55, col. 8 lines 35 to col. 9 lines 43).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

19. In reference to claim 30, Sitnik teaches synthesizing and presenting the contents and the advertising data corresponding to the advertising frame information (for a

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particular frame length and size for example) to a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and lines 44-56).

Sitnik does not teach the transaction method for purchasing advertisement frames via a computer system. Brown teaches the transaction method to carry out a purchase via a computer system (col. 3 lines 29-38, col. 6 lines 6-11, col. 6 lines 60-col. 7 line 1, col. 7 lines 46 to col. 8 lines 13, col. 8 lines 35-61, and Figures 1, 6, 7, 9, and 10). It would have been obvious to modify Sitnik to include a transaction method to enable advertisers a way to carry out the purchase of advertisement frames via a computer system. Furthermore, providing the means to carry out the transaction of purchasing advertisement frames online would enable customers to conduct transactions on a global basis.

20. In reference to claim 32, Sitnik teaches the program further comprising: the recording media embodying the program further comprising: means for synthesizing the contents and advertising data and means for presenting the synthesized contents to a contents user (col. 2 lines 23-26, 44-46, 52-55, 61-65, col. 4 lines 8-34, col. 5 lines 57 to col. 6 lines 3, col. 9 lines 21-24, and 44-56, and col. 7 lines 29-40).

### **Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Business/High Tech Editors. "Freeinternet.com Introduces B2B Division Featuring "Merchantzadz" Ad Buying Program." Business Wire. August 2, 2000. Pages 1-2.
- b) Davis Patent Number 6,269,361. Teaches a system and method for influencing a position on a search result list generated by a search engine.
- c) Roth Patent Number 6,285,987. Teaches an Internet advertising system.

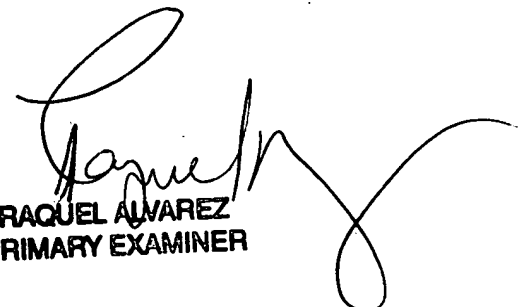
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

October 6<sup>th</sup>, 2005

  
**RAQUEL ALVAREZ**  
**PRIMARY EXAMINER**